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REMARKS

A. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the Claims, the two attached Declarations and the following remarks.

At the outset, the Examiner will note that the 132 Declaration is unexecuted, however, the data contained therein was provided by the Declarant and the unexecuted Declaration has been forwarded to the Declarant for execution. Thus, in order to expedite prosecution in this Application, it is respectfully requested that the Examiner consider the data as contained in the 132 Declaration. The executed 132 Declaration will be submitted as soon as it is received by the below-signed.

Claims Status

Claims 1, 3, 5-11, and 13-19 are pending in this Application. Claims 2 and 12 have been canceled herein.

Claim 1 has been amended herein to recite that the particles contained in the layer that contacts the toner are hydrophobic silica particles. Support for this amendment can be found on page 12 at line 20.

Claim 18 has also been amended herein to clarify that individual latent images are formed on multiple photoreceptors and each of the individual latent images is developed. Such is shown in Figure 1 and discussed in the Application starting at page 6, line 8 going over to the bottom of page 7.

Claim Rejection of Claim 18 Under 112

Claim 18 had been rejected as being indefinite in that it was not clear whether each of the latent images is being developed with a different developer and whether each of the latent images uses the toner of Claim 1.

Claim 18 has been amended herein to specify that each of the latent images is developed on a different developer. Additionally, the latent images are developed with toner of Claim 1. Respectfully, Claim 18, as amended herein, is definite.

Prior Art Rejections Based on Asano

Claims 1, 2, 5-9, 12-15, 18 and 19 had been rejected as being unpatentable over a combination of Asano and Uchida and Claim 10 had been rejected as being unpatentable over a combination of Asano and Uchida as applied to Claim 8 and further in view of additional teachings of Asano.

In Applicants' previous Response, they had submitted a Declaration to demonstrate that Applicants have reduced to practice their Invention prior to February 28, 2003, the effective prior art date of Asano. The Examiner had taken

the position that that Declaration failed to establish a reduction to practice because there was no showing of fact to establish reduction to practice. In response to the Examiner's position, a 131 Declaration is submitted herewith. The Examiner's attention is directed to Paragraph 6 which states that the tests and the Examples that are reported in JP '618 were performed by the Inventors or under their direct supervision and control at least as early as December 24, 2002. Thus, the Japanese Application, '618, presents evidence of specific tests that were conducted and the results obtained from those experiments.

The Examiner will note that, in Paragraphs 89-90 of JP '618, it teaches the steps of forming, transferring and fixing as recited in Claim 1. The toner having the claimed average circular degree and containing a wax having an ester is taught in Paragraph 76 and in Table 3 of JP '618. The surface layer having the claimed surface roughness, R_a , and containing hydrophobic silica particles having a claimed number average primary particle diameter, are recited in Paragraph 73 of JP '618. Thus, the examples of JP '618 demonstrate that the present Invention was reduced to practice prior to the U.S. filing date of Asano.

Furthermore, it will be noted that the disclosure in JP '618 is substantially the same as the disclosure in this Application.

Thus, Applicants have shown facts which are credible and establish that prior to the effective date of the reference they had reduced the image as claimed herein to practice.

Prior Art Rejection Based on Chambers

The Examiner has made three specific prior art rejections based on the fact that Chambers teaches a photoreceptor that is deemed to inherently possess the surface roughness recited in the claims. Specifically, the Examiner has rejected Claims 1, 2, 5, 6, 12-15, 18 and 19 as being unpatentable over a combination of Nagase, Chambers, Inoue and Applicants' admission of Table 4, page 38 of the Application. Claims 3, 16 and 17 have been rejected based on the combination of Nagase, Chambers, Inoue, Applicants' admission as noted above and further in view of Hagi. Finally, Claims 6-11 had been rejected as being unpatentable over a combination of Nagase, Chambers, Inoue, Applicants' admission as noted above and JP '417.

Each one of these rejections is based on the Examiner's position that Chambers teaches a photoreceptor that inherently possesses the surface roughness as recited in the claims. The Examiner, as noted on page 17, line 3, has placed the burden on the Applicants to prove that Chambers does not possess the surface roughness of the recited claims.

In order to respond to the Examiner's position, attached is a 132 Declaration. Applicants have made the four different photoreceptors recited in Chambers, namely, the photoreceptor of Example 1, the photoreceptor of Example 2, the photoreceptor of Comparative Example 2 and the photoreceptor of Comparative Example 3. Each one of these photoreceptors was then tested to determine the surface roughness of the layer that comes in contact with the toner.

As noted in the Table that is reported in Paragraph 5 of the Declaration, none of these photoreceptors even came close to having a layer with a surface roughness as recited in the claims. The Examiner will note the surface roughness recited in the claims is between 0.02 to 0.1 μm . The surface roughness of the photoreceptor, as taught in Chambers were 0.18 to 0.29. Thus, the surface roughness of the surface layer of the photoreceptors of Chambers are in the neighborhood as twice as large as the upper limit of the claimed surface roughness.

Respectfully, Applicants have proven that Chambers does not have the surface roughness as recited in the claims.

Since none of the other references cited by the Examiner in combination with Chambers possess a photoreceptor which is deemed to inherently meet the claimed surface roughness, it is respectfully submitted that the claims presented herein are patentable over the Examiner's rejections which are based on Chambers.

Rejections Based on JP '040

Claims 1-17 and 19 have been rejected as being unpatentable over a combination of JP '040 and Uchida. Claims 1-3, 5, 6 and 12-19 have been rejected as being unpatentable over a combination of Nagase and JP '040. Finally, Claims 6-11 have been rejected as being unpatentable over a combination of Nagase, JP '040 and JP '417.

Claim 1 has been amended herein to recite that the layer on the photoreceptor contains hydrophobic silica particles. All of the other claims recited herein ultimately depend upon Claim 1 and, thus, all of the claims presented herein require that the layer that makes contact with the toner during the development step containing the hydrophobic silica particles.

JP '040 neither teaches nor suggests hydrophobic silica nor that the layer that contacts the toner in the development step contains hydrophobic silica. JP '040 teaches inorganic metal oxide particles are contained in the protective layer, see paragraphs 28, 36-42 and 116-128. JP '040 does not teach the use of hydrophobic silica.

As mentioned, Paragraph 28 of JP '040, the protective layer is obtained by reacting organic silicon compound having a hydroxyl group or a hydrolytic group. These compounds are generally hydrophilic. Additionally, as mentioned in Paragraph 29, the hydrophilic solvent is used to form the coating composition for the protective layer of the photoreceptor. Thus, to disperse the inorganic metal particles uniformly in a protective layer the inorganic metal particles are hydrophilic.

Respectfully, one of skill in the art does not consider hydrophobic particles to be equivalent to hydrophilic particles and, thus, it is respectfully submitted that JP '040 actually teaches away from the use of hydrophobic silica in the layer of the photoreceptor that touches the toner.

Uchida is silent with respect to hydrophobic silica in the layer. Thus, the combination of Uchida and JP '040 cannot teach or suggest the Invention as recited in the claims herein.

Nagase also fails to teach the use of hydrophobic silica and, thus, the combination of Nagase and JP '040 cannot teach or suggest the claims herein.

JP '417 fails to teach hydrophobic silica in the layer. Thus, the combination of JP '417 with JP '040 and Nagase does not teach or suggest a layer as recited herein containing the hydrophobic silica.

Respectfully, the claims presented herein are patentable over the various references in combination with JP '040 since they do not teach or suggest the use of hydrophobic silica in the layer.

It will be noted that Chambers teaches the use of hydrophobic silica, see Column 13, line 63 of Chambers. However, as noted above, a photoreceptor made in accordance with Chambers does not meet the surface roughness as recited in the claims. Thus, it is respectfully submitted that Chambers in combination with the references, as noted above, does not result in a photoreceptor as recited in the claims.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the claims are patentable over the references taken alone or in combination. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:



Donald C. Lucas, 31,275
Attorney for Applicant(s)
475 Park Avenue South, 15th Floor
New York, NY 10016
Tel. # 212-661-8000

Encl: Executed 1.131 Declaration signed on October 2, 2006
Unexecuted copy of 132 Declaration